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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,942	12/27/2000	Charles A. Eldering	T721-15	6478

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EXPANSE NETWORKS, INC.
6206 KELLERS CHURCH ROAD
PIPERSVILLE, PA 18947

EXAMINER

SHELTON, BRIAN K

ART UNIT	PAPER NUMBER
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2611

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DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,942

Applicant(s)

ELDERING ET AL.

Examiner

Brian Shelton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3,4,5,6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the Application filed 27 December 2000.
2. The Application has been examined. **Claims 1-14** are pending. The objections and rejections cited are as stated below.

Claim Objections

3. **Claim 12** is objected to because of the following informalities:

In claim 12 at lines 11-12, "at least one of the at least one queue" should be changed to --the at least one queue--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 1-2 and 4-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (Picco), U.S. Patent No. 6,029,045 in view of Guyot et al. (Guyot), U.S. Patent No. 6,119,098 (both provided by applicant in the IDS filed 6/15/2001)

Regarding **claim 1**, Picco discloses in a television network system, subscriber equipment for displaying targeted advertisements to a subscriber (col. 7, lines 35-51), the subscriber equipment comprising:

- (a) a communications interface (Fig. 7; Tuner **180** and Decoder **182**) for receiving targeted advertisements and advertisement control data (col. 11, lines 18-37 [receiving local content at communications interface]; col. 7, line 48-56 [content profile data associated with local content transmitted to set top box] col. 8, lines 7-22 [set top box utilization of content profile data for advertisement insertion operations]), wherein the advertisement control data is selectively distributed to the subscriber (col. 7, lines 6-12 [uplink facility selectively distributing content and associated content profile data]);
- (b) memory (disk **186**) for storing queue of selectively distributed advertisements and advertisement control data (col. 11, lines 35-44);
- (c) a processor (CPU **188** and splicers **190** and **192**) for inserting the targeted advertisements in program streams for display to the subscriber (col. 11, lines 49-51).

Although Picco discloses the communications interface receiving targeted of advertisements with advertisement control data, Picco fails to specifically disclose the communication interface receiving a queue of targeted ads, as claimed. Picco further fails to disclose a trigger circuit, as claimed.

However, Guyot, in an analogous art, teaches receiving a queue of advertisements (col. 3, lines 49-54, describing server transmission of targeted advertisements to subscriber; col. 4, line 35 – col. 5, line 5, describing advertisement queue and associated data defining presentation of targeted advertisements) and further teaches a trigger circuit which determines if a queue of advertisements has reached a low-level, wherein a communications interface receives an additional queue of ads in response to the determination (col. 7, lines 4-11 [low level trigger]; see col. 2, lines 30-36; see also col. 11, lines 59-62) for the benefit of providing a distributor of a plurality of advertisements enhanced control over the manner in which individual advertisements are displayed and for continually updating advertisements that have been displayed a predetermined number of times with new advertisements in a system for displaying targeted advertisements.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communications interface of Picco to include receiving at least one queue of targeted advertisements, wherein the queue is selectively distributed to the subscriber and further, to modify the subscriber equipment of Picco to include a trigger circuit for determining if the at least one queue has reached a low-level, wherein said communications interface receives at least one additional queue of targeted advertisements in response to a low-level determination by said trigger circuit, as taught by Guyot, for the benefit of providing a distributor of a plurality of advertisements enhanced control

over the manner in which individual advertisements are displayed in a system for displaying targeted advertisements and for continually updating advertisements that have been displayed a predetermined number of times with new advertisements in a system for displaying targeted advertisements in a in a system for displaying targeted advertisements.

The limitation of **claim 2** is encompassed by the teachings of Picco in view of Guyot, as discussed above relative to claim 1. Specifically, Guyot discloses a counter for tracking number of times each targeted advertisement is displayed to a subscriber (Total Ad Playing Counter, col. 5, lines 3-5).

The limitation of **claim 5** is encompassed by the teachings of Picco in view of Guyot, as discussed above relative to claim 1. Specifically, Guyot discloses for each targeted advertisement within the queue, the queue includes advertiser data identifying the advertiser sponsoring the advertisement (Advertiser data, col. 3, line 66 – col. 4, line 1).

The limitation of **claims 6 and 7** is encompassed by the teachings of Picco in view of Guyot, as discussed above relative to claim 1. Specifically, Guyot discloses for each targeted advertisement with the queue, the queue includes a time frame defining a time during which the targeted advertisement should be displayed includes:

- (a) a hour frame indicating the hours of the day during which the advertisement should be displayed (Ad Hour Frames, col. 4, lines 56-57);
- (b) a day frame indicating the days of the week, month or year during which the advertisement should be displayed (Ad Day Frames, col. 4, lines 58-59);
- (c) a week frame indicating the weeks of the month or year during which the advertisement should be displayed (Ad Week Frames, col. 4, lines 60-61); and
- (d) a month frame indicating the months of the year during which the advertisement should be displayed (Ad Month Frames, col. 4, lines 62-63).

The limitation of **claim 8** is encompassed by the teachings of Picco in view of Guyot, as discussed above relative to claim 1. Specifically, Guyot teaches for each targeted advertisement within the queue (col. 4, lines 35-39), the queue includes ***at least one of:***

- (a) an expiration date of the targeted advertisement (Ad Expiration Date, col. 4, lines 44-45);
- (b) a maximum total number of times the targeted advertisement should be displayed (Ad Play Times Maximum Number, col. 4, lines 42-43);

- (c) a maximum number of time the targeted advertisement should be displayed each day (Ad Frequency, col. 4, lines 64-65);
- (d) a total number of times the targeted advertisement has previously been displayed to the subscriber (Total Ad Playing Counter, col. 5, lines 2-5); and
- (e) a number of times the targeted advertisement has been displayed that day (Daily Ad Playing Counter, col. 4, lines 66-67).

The limitation of **claim 9** is encompassed by the teachings of Picco in view of Guyot, as discussed above relative to claim 1. Specifically, Guyot discloses the trigger circuit determines that the queue has reached a low-level if the queue has less than a particular number of targeted advertisements remaining (col. 7, lines 4-10).

The limitation of **claim 10** is encompassed by the teachings of Picco in view of Guyot, as discussed above relative to claim 1. Specifically, Guyot teaches a communications interface is connectable to an advertisement management system (Fig. 3, processor **210**) over a network connection (communications link **400**) wherein the targeted advertisements are identified by the advertisement management system based on a profile of the subscriber supplied to the advertisement management system (col. 3, lines 43-54; see also

col. 3, lines 61-65, describing subscriber personal profile utilized by processor **210** in advertisement targeting).

The limitation of **claim 11** is encompassed by the teachings of Picco in view of Guyot, as discussed above relative to claim 1. Specifically, Guyot teaches the at least one queue includes a state indicator for activating said trigger circuit (col. 6, line 64 – col. 7, line 10; Fig. 5, el. **S200**).

As for **claims 13 and 14**, Picco discloses a set-top box for inserting targeted advertisements in place of default advertisements with television program streams and corresponding method (Figs. 7 and 10; col. 7, lines 35-51), comprising:

- (a) a communications interface (Fig. 7; Tuner **180** and Decoder **182**) for receiving a plurality of targeted advertisements and advertisement control data identifying criteria for inserting the targeted advertisements(col. 11, lines 18-37 [receiving local content at communications interface]; col. 7, line 48-56 [content profile data associated with local content transmitted to set top box] col. 8, lines 7-22 [set top box utilization of content profile data for advertisement insertion operations]);
- (b) memory (disk **186**) for storing queue of selectively distributed advertisements and advertisement control data (col. 11, lines 35-44);

- (c) a processor (CPU **188** and splicers **190** and **192**) for determining when and what targeted advertisement should be inserted into the program stream (col. 11, lines 49-51).
- (d) an inserter (audio splicer **190** and video splicer **192**) for inserting the target advertisement into the program stream (col. 11, lines 49-51).

Although Picco discloses the communications interface receiving a plurality of advertisements with advertisement control data, Picco fails to specifically disclose the communication interface receiving a queue of ads, as claimed.

Picco further fails to disclose a trigger circuit, as claimed.

However, Guyot, in an analogous art, teaches receiving a queue of advertisements (col. 3, lines 49-54, describing server transmission of targeted advertisements to subscriber; col. 4, line 35 – col. 5, line 5, describing advertisement queue and associated data defining presentation of targeted advertisements) and further teaches a trigger circuit which determines if a queue of advertisements has reached a low-level, wherein a communications interface receives an additional queue of ads in response to the determination (col. 7, lines 4-11 [low level trigger]; see col. 2, lines 30-36; see also col. 11, lines 59-62) for the benefit of providing a distributor of a plurality of advertisements enhanced control over the manner in which individual advertisements are displayed and for continually updating advertisements that have been displayed a predetermined number of times with new advertisements.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the set-top box Picco to include the communications interface receiving a queue identifying criteria for inserting targeted advertisements, memory for storing the queue, and the processor determining when and what targeted advertisement should be inserted into the program stream based on the queue and, further, to include a trigger circuit for determining when the targeted advertisements and the queue need to be refreshed, as taught by Guyot, for the benefit of providing a distributor of a plurality of advertisements enhanced control over the manner in which individual advertisements are displayed in a system for displaying targeted advertisements and for continually updating advertisements that have been displayed a predetermined number of times with new advertisements in a system for displaying targeted advertisements.

6. **Claims 3-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (Picco), U.S. Patent No. 6,029,045 in view of Guyot et al. (Guyot), U.S. Patent No. 6,119,098, as applied to claim 1, further in view of Khoo et al. (Khoo), U.S. Patent 6,434,747.

As for **claim 3**, the teachings of Picco in view of Guyot are relied upon as discussed above relative to claim 1. Guyot teaches the communications interface also receives the targeted advertisements and the memory stores the targeted advertisements. However, although Guyot teaches the queue identifying ad presentation criteria (col. 4, line 35 – col. 5, line 5), Picco in view of Guyot fails to specifically disclose the queue identifying the sequence for the processor to insert advertisements, as claimed.

But Khoo, in an analogous art, teaches advertisement queues which identify a sequence for a processor to insert targeted advertisement in a program display (col. 7, lines 18-36, describing customized media list, which comprises list of customized advertising commercials which are sequenced in a predetermined order) for the benefit of defining an arrangement in which each of a group of advertisements are to be displayed.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the queue of Picco in view of Guyot to incorporate the queue identifies a sequence for said processor to insert the targeted advertisement in the program stream for display to the subscriber, as taught by Khoo, for the benefit of defining an arrangement in which each of a group of advertisements are to be displayed in a system for displaying targeted advertisements.

The limitation of **claim 4** is encompassed by the teachings of Picco in view of Guyot, further in view of Khoo, as discussed above relative to claim 3.

Specifically, Guyot discloses each advertisement stored in memory is identified by an advertisement identifier that uniquely identifies the targeted advertisement and the at least one queue reference the advertisement identifier (Ad Identification, col. 4, lines 35-41).

7. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (Picco), U.S. Patent No. 6,029,045 in view of Guyot et al. (Guyot), U.S. Patent No. 6,119,098, further in view of Khoo et al. (Khoo), U.S. Patent 6,434,747.

Regarding **claim 12**, Picco discloses in a television network system, a system for displaying targeted advertisements to subscribers (col. 4, lines 51-65), the system comprising:

an advertisement management system (Fig. 4; Agent **150**, Statistical Collector **152**, Local Content **108**, Scheduler **148** and Database **146**) for generating targeted advertisements for a subscriber (col. 6, line 57 – col. 7, line 32);

an advertisement distribution system (Fig. 4, Transmitter **144**, Uplink Antenna **110**, and Satellite **104**) for distributing targeted advertisements to the subscriber over the television network (col. 6, lines 52-56; col. 23-39 {transmission of advertisement content and control data to set top boxes}; and

subscriber equipment for receiving targeted advertisements and the at least one queue and displaying the targeted advertisements to the subscriber (col. 7, lines 35-51), the subscriber equipment including:

- (a) a communications interface (Fig. 7; Tuner **180** and Decoder **182**) for receiving targeted advertisements and (col. 11, lines 18-37 [receiving local content]; plurality of advertisements and associated content profile data, col. 6, line 61 – col. 7, line 2), wherein the at least one queue is selectively distributed to the subscriber (geographic localization; col. 6, lines 57-61);
- (b) memory (disk **186**) for storing the at least one queue of selectively distributed advertisements (col. 11, lines 35-44);
- (c) a processor (CPU **188** and splicers **190** and **192**) for inserting the targeted advertisements in program streams for display to the subscriber (col. 11, lines 49-51).

Picco fails to disclose the advertisement management system identifying targeted advertisements, as claimed and generating at least one queue of targeted advertisements, as claimed. Additionally, Picco fails to disclose the advertisement distribution system distributing at least one queue, as claimed.

And although Picco discloses the communications interface receiving a plurality of advertisements with advertisement control data, Picco fails to specifically disclose the communication interface receiving a queue of ads, as claimed.

Picco further fails to disclose a trigger circuit, as claimed.

However, Guyot, in an analogous art, teaches a system for displaying advertisements comprising an advertisement management system (Fig. 3, Processor **210**) which identifies targeted advertisements for a subscriber by correlating advertisement profiles with a subscriber profile (col.3, lines 49-54) and generates a queue of targeted advertisements for the subscriber (col. 3, lines 49-54, describing server transmission of targeted advertisements to subscriber); an advertisement distribution system (communications link **400**) which distributes the queue to a subscriber (col. 3, lines 45-47); and subscriber equipment (Fig. 2) which receives the queue including a memory for storing the queue (col. 4, lines 35-39), and a processor (Processor **310**), responsive to the queue, for inserting targeted advertisements in a display (col. 5, lines 6-18, describing presentation of ads; col. 4, line 35 – col. 5, line 5, describing advertisement queue and associated data defining presentation of targeted advertisements) and further teaches a trigger circuit which determines if a queue of advertisements has reached a low-level, wherein a communications interface receives an additional queue of ads in response to the determination (col. 7, lines 4-11 [low level trigger]; see col. 2, lines 30-36; see also col. 11, lines 59-62) for the benefit of providing a distributor of a plurality of advertisements enhanced control over the manner in which individual advertisements are displayed and for continually updating advertisements that have been displayed a predetermined number of times with new advertisements.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the advertisement system of Picco to incorporate an advertisement management system which identifies targeted advertisements for a subscriber by correlating advertisement profiles with a subscriber profile and generating at least one queue of targeted advertisements for the subscriber; an advertisement distribution system for distributing the queue; and subscriber equipment for receiving at least one queue of targeted advertisements, wherein the queue is selectively distributed to the subscriber and to include a trigger circuit for determining if the at least one queue has reached a low-level, wherein said communications interface receives at least one additional queue of targeted advertisements in response to a low-level determination by said trigger circuit, as taught by Guyot, for the benefit of providing a distributor of a plurality of advertisements enhanced control over the manner in which individual advertisements are displayed in a system for displaying targeted advertisements and for continually updating advertisements that have been displayed a predetermined number of times with new advertisements in a system for displaying targeted advertisements.

However, although Guyot teaches the queue identifying ad presentation criteria (col. 4, line 35 – col. 5, line 5), Picco in view of Guyot fails to specifically disclose the advertisement management system generating a queue identifying the sequence for the presenting the targeted advertisements, as claimed.

But Khoo, in an analogous art, teaches an advertisement management system comprising advertisement queues which identify a sequence for presenting targeted advertisements to the subscriber (col. 7, lines 18-36, describing customized media list, which comprises list of customized advertising commercials which are sequenced in a predetermined order) for the benefit of defining an arrangement in which each of a group of advertisements are to be displayed.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the advertisement management system of Picco in view of Guyot to incorporate each of the at least one queue identifies a sequence for said processor to insert the targeted advertisements to the subscriber, as taught by Khoo, for the benefit of defining an arrangement in which each of a group of advertisements are to be displayed in a system for displaying targeted advertisements

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Swix et al. (Swix), U.S. Patent No. 6,718,551 discloses a system for providing targeted ads over a networked media system (abstract) wherein an

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advertisement playlist is created for displaying targeted advertisements on subscriber equipment (Fig. 4, col. 11 line 58 –col. 12 line 19).

Zigmond et al. (Zigmond), U.S. Patent No. 6,698,020 discloses a system for selectively inserting advertisements into programming wherein the advertisements are stored at an ad insertion device and selectively inserted according to ad selection criteria stored at the insertion device (abstract, Fig. 5, col. 10, line 16 – col. 15, line 23).

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Shelton whose telephone number is (703) 305-4700. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Brian Shelton
Examiner
Art Unit 2611

BS


CHRIS GRANT
PRIMARY EXAMINER